

REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Claims 1-19 were pending prior to the Office Action. Claims 20-32 have been added through this Reply. Claims 1-32 are pending. Claims 1, 10, 16, 20, and 29 are independent.

NO CHANGE IN SCOPE

It is noted that some of the claims 1-19 have been amended. These claims have been amended merely to address minor informal issues. It is intended that the scope of the claims remain unchanged.

§ 102 REJECTION – GARFINKLE

Claims 1-4 and 7-19 stand rejected under 35 USC 102(b) as allegedly being anticipated by Garfinkle et al. (USP 6,017,157). *See Office Action, item 3.* Applicants respectfully traverse.

For a Section 102 rejection to be proper, the cited reference must teach or suggest each and every claimed element. *See M.P.E.P. 2131; M.P.E.P. 706.02.* Thus, if the cited reference fails to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, Garfinkle fails to teach or suggest each and every claimed element. For example, independent claim 1 recites, in part “when the

recording medium, storing a digital image data, a server-connection address information, and a designated print-order acceptor information, is mounted to the terminal unit, said terminal unit is connected to said order receiving server ... so as to transmit said designated print-order acceptor information and at least a part of said digital image data to said order receiving server.” In other words, the digital image data as well as connection information are stored in the recording medium and the recording medium is mountable to the terminal unit. When the recording medium is mounted to the terminal unit, the terminal unit transmits information to the order receiving server so that image printing may take place. Independent claims 10 and 16 also recite similar features.

Garfinkle cannot be relied upon to teach or suggest at least this feature. Garfinkle is directed toward processing digital images and distributing visual prints produced from the digital images. *See column 1, lines 8-14.* In Garfinkle, all images are first uploaded to an image server 16. For example, Figure 1 of Garfinkle shows that image is uploaded to the image server through the upload interface A by either the photographer 8 or by operation of the scanning center 14.

In Garfinkle, it is critical that the images are first stored in the image servers. For example, Garfinkle states “in a preferred embodiment, the digital images are stored ... one or more image servers 16 from which images are accessible by the photographer 8.” Garfinkle also states, “in a most preferred

embodiment, each digital image is scanned in JPEG format and stored in a computer database on one or more image servers 16.” *See column 3, line 67 – column 4, line 2.*

Garfinkle also discloses the manner in which the images may be stored on the image servers. Garfinkle states, “the individual digital images may be stored in a single directory on each image server 16, with database entries identifying the location of the digital images and any related information.” *See column 4, lines 2-6.* Garfinkle further discloses that unique access code is associated with the images so that they may be accessed. Garfinkle states “a unique access code is associated with the digital images to facilitate secure viewing of the images from a separate second location through the use of the interface B.” *See column 4, lines 57-60.* As shown in Figure 1, the photographer 8 may access the images on the image server 16 through the interface B once the images have been uploaded to the image server.

When a print is desired, the photographer may use the fulfillment center 20 and place orders for the images. *See column 9, lines 1-13.* Retrieving of the images to fulfill any order is performed by interfacing with the image server 16.

However, Garfinkle is entirely silent regarding a recording medium mounted on a terminal wherein the mounted recording medium includes all information necessary to generate a print order including image data, server-connection address information, designated print-order acceptor information,

etc. Indeed, because Garfinkle heavily depends on a centralized image server for storage of the images, Garfinkle actually teaches away from this feature.

Therefore, independent claims 1, 10 and 16 are distinguishable over Garfinkle. Claims 2-4, 7-9, 11-15 and 17-19 depend from independent claims 1, 10, and 16, directly or indirectly. Therefore, for at least the reasons stated with respect to independent claims, these dependent claims are also distinguishable over Garfinkle.

Applicants respectfully request that the rejection of claims 1-3 and 6-19 based on Garfinkle be withdrawn.

§ 103 REJECTION – GARFINKLE, FANNING

Claims 5 and 6 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Garfinkle in view of Fanning et al. (USP 6,742,023). Applicants respectfully traverse.

It is noted that claims 5 and 6 depend from independent claim 1. It has been demonstrated above that independent claim 1 is distinguishable over Garfinkle. Fanning has not been, and indeed cannot be relied upon to correct for at least the above-noted deficiencies of Garfinkle. Therefore, independent claim 1 is distinguishable over the combination of Garfinkle and Fanning. For at least due to the dependency thereon, claims 5 and 6 are also distinguishable over the combination of Garfinkle and Fanning.

Applicants respectfully request that the rejection of claims 5 and 6 based on Garfinkle and Fanning be withdrawn.

NEW CLAIMS

Claims 20-32 have been added through this reply. All new claims are believed to be distinguishable over the cited references, individually or in any combination. Applicants respectfully request that the new claims be allowed.

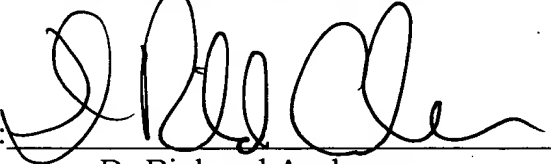
CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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